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7/10/02  
Attorney Docket: 678-427 (P8990)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT:** Soon-Jin KIM **EXAMINER:** Tu X. Nguyen  
**SERIAL NO.:** 09/473,360 **GROUP ART UNIT:** 2682  
**FILED:** December 28, 1999 **DATED:** June 14, 2002  
**FOR:** METHOD AND SYSTEM FOR TRANSMITTING CHARACTER  
MESSAGES IN MOBILE COMMUNICATION TERMINAL DURING  
CONVERSATION BY TELEPHONE

Assistant Commissioner for Patents  
Washington, D.C. 20231

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**RESPONSE**

Technology Center 2600

Sir:

The application has been reviewed in light of the Office Action dated March 14, 2002. Claims 1-5 are pending in this application.

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231 on June 14, 2002.

Dated: June 14, 2002

*Barbara Evers*  
Barbara Evers

Independent Claim 1 was rejected in the Office Action under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,301,338 to Makela et al. (Office Action, ¶12) Regarding Claim 1, the Office Action cites col. 3, lines 35-37, of Makela for purportedly teaching setting a mobile communication terminal to a character message transmitting/receiving mode while in a state in which a speech path has been established between the mobile communication terminal and a mobile communication terminal of a party other than the user. Citation is also made in the Office Action to col. 7, lines 22-30, of Makela for purportedly teaching the inputting of a character message while in the character message transmitting/receiving mode, processing the written character message and transmitting the written character message to the communication terminal of a party other than the user via the established speech path in the character message-transmitting receive mode.

The current invention relates to transmitting a character message in a mobile communication terminal during a conversation by telephone. In the method recited in Claim 1, a speech path has been established between the mobile communication terminal and a mobile communication of a party other than the user (also referred to below as the "other mobile communication terminal"). While in the state in which the speech path has been established, the mobile communication terminal is set to a character message-transmitting/receiving mode. A character message is input while in the character message-transmitting/receiving mode, and the character message is processed and transmitted to the other mobile communication terminal via the established speech path in the character message-transmitting/receiving mode.

Thus, as recited in Claim 1, the current invention provides for a character

message to be input and transmitted to the other mobile communication terminal during a telephone conversation (when a speech path has been established). This allows, for example, the user to input and immediately send a character message when speaking suddenly becomes inconvenient, impractical, etc., such as at the start of a business meeting. In addition, the character message is transmitted to the other mobile communication terminal via the established speech path.

The Makela patent is principally directed to setting an option whereupon a mobile phone responds to an incoming call that has not been connected by transmitting a short message (SM) back to the caller. Makela does not mention sending a short message while the incoming call is being received. Thus, Makela does not teach sending a short message "while in a state in which a speech path has been established", as recited in Claim 1. In addition, Makela specifically states that "[s]hort message refers in this patent application to data transfer determined by certain telephone systems in the form of a character string, where no actual telephone connection is required to be formed but it is transferred as a so called signaling". (Makela, col. 3, line 66, to col. 4, line 3) Thus, Makela also fails to teach "transmitting the written character message...via the established speech path", as recited in Claim 1.

As to the specific portions cited by the Examiner in Makela, they do not teach what is ascribed to them. Col. 3, lines 35-37 states that the reply to an incoming call may be an SMS message, but lines 28-31 of col. 3 make clear that this SMS reply is when "the user of the communication device can't answer the call". This reinforces the above-noted point that the SMS message of Makela is a reply to an incoming call that has not been connected, not a character message sent after a speech path has been

established.

Similarly, col. 7, lines 22-30, cited in the Office Action is part of a description of how the user can create and store short messages and then invoke a function whereupon short messages reply to incoming calls. Thus, the call is not connected and the short message is not transmitted via a speech path. Although not cited in the Office Action, col. 8, lines 42-64, of Makela refers to the user sending a voice message during a telephone conversation. Although this would thus take place while a speech path is established, the description is that of a voice message being transmitted over the call path, not a short message.

For at least the above-discussed reasons, independent Claim 1 is patentably distinct from Makela. Reconsideration and allowance of Claim 1 is thus respectfully requested.

Independent Claim 5 was rejected in paragraph 4 of the Office Action under 35 U.S.C. §103(a) as obvious over Makela in view of U.S. Patent No. 6,208,878 to Hattori et al. Because independent Claim 5 includes analogous recitations to those found in Claim 1 discussed above that distinguished Claim 1 from Makela, Claim 5 may be distinguished from the combination of Makela and Hattori for like reasons. Allowance of Claim 5 is thus respectfully requested.

Finally, without conceding the patentability per se of dependent Claims 2-4, it is submitted that they are allowable by virtue of their dependency on independent Claim 1. In view of the foregoing remarks, it is respectfully submitted that all of the claims now pending in the application, namely Claims 1-5 are in condition for allowance. Early and favorable consideration and allowance of Claims 1-5 is respectfully

requested. Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, he is respectfully requested to phone applicants' attorney at the number indicated below.

Respectfully submitted,



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